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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,989	02/18/2004	Elisabeth Eduarda Catharina Geertruida Gielens	71489 US02	3314

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EXAMINER

SASTRI, SATYA B

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/780,989

Applicant(s)

GIELENS ET AL.

Examiner

Satya B. Sastri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-39, 44-64 and 66 is/are rejected.
- 7) ☒ Claim(s) 12, 40-43 and 65 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/12/04, 10/21/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response to application filed on February 2, 2004. *Claims 1-66* are now pending in the application.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: There is no description of the drawn shown as Fig 1. A brief description of the figure must be included before the detailed description of the invention.

Appropriate correction is required.

#### ***Claim Objection***

3. The scope of the claim is unclear because of the inclusion of acrylonitril, cycloaliphatic acid and acrylate groups in the Markush group.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. **Claim 63** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claim recites the transitional phrase "consisting essentially of" and includes at least one acrylic polymer and at least one tackifier resin. The composition is essentially open ended to other acrylic polymers and tackifiers and thus, remains unclear as to which ingredients do not materially affect the basic and novel characteristics of the claimed composition.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA, 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. *Claims 1, 50-53* are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *claims 48, 51-54* over claims in copending application 10/780,996 to Theelen et al. (amendment filed on October 17, 2005, published as US 2005/0182150).

Although the claims are not conflicting, the claims of the instant application overlap the scope of the copending claims. The difference between the copending claims and the instant invention is that the copending claims teach adhesive compositions comprising the specific species of radiation curable acrylic polymer. It would have been obvious to a skilled artisan that acrylic polymers in general would be effective adherents in the adhesive compositions.

8. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 10/780,996, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting

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inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

9. *Claims 1, 50-53* are directed to an invention not patentably distinct from *claims 48, 51-54* of commonly assigned 10/780,996 to Theelen et al. (amendment filed on October 17, 2005, published as US 2005/0182150). Specifically, instantly recited compositions comprising acrylic polymers read on compositions comprising radiation curable acrylic polymer of the copending application.

10. *Claims 1-66* are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *claims 1-67* over claims in copending application 10/780,987 to Theelen et al. (published as US 2005/0182184) in view of Bernard (US 5,623,011).

Although the claims are not conflicting, the claims of the instant application are obvious over copending claims. The difference between the copending claims and the instant invention is that the prior art teaches acrylic tackifying resins useful in adhesive compositions. The secondary reference teaches the adhesives comprising acrylic resins and tackifying resins. It is the examiner's position that acrylic tackifying resins would show good compatibility with the

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acrylic resins in the compositions disclosed by Bernard. Thus, it would have been obvious to one skilled in the art to include acrylic tackifying resins in the compositions of Bernard and thereby obtain the instant invention.

11. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 10/780,987, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

12. ***Claims 1-66*** are directed to an invention not patentably distinct from ***claims 1-67*** of commonly assigned 10/780,987 to Theelen et al. (published as US 2005/0182184) in view of Bernard (US 5,623,011). Specifically, it would have been obvious to a skilled artisan to use

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tackfying resins of the copending application in an acrylic adhesive composition as taught by Bernard.

### ***Claim Analysis***

13. Instant claims recite compositions comprising tackfying resins with low residual monomer contents. It is the examiner's position that the tackfying resin composition is devoid of large amounts of residual monomer but the adhesive composition is open ended to containing varying amounts acrylic polymers and other acrylic monomers given that the transitional phrase "comprising" is used in the claim language.

### ***Claim Rejections - 35 USC § 102 and 103***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. ***Claims 1-11, 13-39, 44-50, 54-64, 66*** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Whitmire et al. (US 4,912,169).



Whitmire et al. disclose adhesive compositions comprising a polymeric additive polymerized from acrylic monomers, olefinic acids and optional comonomers wherein said additive has molecular weight less than 35,000 and softening point greater than 40°C (abstract). The additive component may be used with polymers or copolymers of styrene, butadiene, ethylene, vinyl acetate, (meth)acrylic acids or esters with (meth)acrylic acids or esters as the preferred species (column 4, lines 10-21). The polymeric additive may be derived from a variety of monomers disclosed in column 2 including ethylhexyl acrylate, unsaturated acids and aromatic monomers (column 3, lines 52-65). Additionally, working example III in table 1 discloses a polymeric additive comprising isobutyl methacrylate, styrene and methacrylic acid, with a molecular weight of 2370 and a softening point of 81°C. The additive is combined with butyl acrylate based emulsion adhesive in amounts of 0-20 parts by wt. (example XXVIII, Table IV). Comparative example discloses a polymeric additive comprising 2-ethylhexyl acrylate and styrene (example XXIV, Table V). Working examples disclose coating the adhesive on PET substrates. Given that the polymeric additives in the working examples are separated from the medium by filtration and isolated, a reasonable basis exists to believe that any unreacted monomer present would inherently be eliminated to afford an additive with low residual monomer. In the alternative, the presently claimed property of low residual monomer would obviously have been present once the Whitmire product is provided. It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103

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such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594, 596 (CCPA 1980).

**Claims 15, 16, 54-56** are product by process claims. Where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to applicants to establish an unobvious difference, even if the production processes are different. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). Furthermore, the patentability of a product claim rests on the product formed and not on the method by which it is produced. *In re Thorpe*, 227, USPQ 984 (Fed. Cir. 1985).

17. **Claims 1-11, 13-39, 44-64, 66** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takizawa et al. (US 6,783,850 B2).

Takizawa et al. disclose adhesive compositions comprising 5-75 parts by wt. of an adherent polymer (a) comprising (meth)acrylic ester component as principal structural unit and (b) 5 to 40 parts by wt. of a tackifying resin comprising (meth)acrylic ester component and having a wt. average molecular wt. of 20,000 or less (abstract). The tackifier resin include (meth)acrylic esters (column 13, lines 34-40) copolymerized with unsaturated carboxylic acids and aromatic monomers (column 12, lines 14-19, column 13, lines 18-22). The polymerization of tackifying resin is advanced to substantially 100% and is excluded of residual solvents (column 15, lines 63-67). The adherent polymer may include (meth)acrylic acids or esters polymerized with other polar unsaturated monomers. Adhesive tapes comprising the adhesive composition are also disclosed. The polymerization of the tackifying resin is advanced to

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substantially 100% and thus, a reasonable basis exists to believe that the tackifying resin would inherently have low residual monomer content. In the alternative, instant claims are anticipated by the prior art. In the alternative, the presently claimed property of low residual monomer would obviously have been present once the Takizawa product is provided. It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594, 596 (CCPA 1980).

**Claims 15, 16, 54-56** are product by process claims. Where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to applicants to establish an unobvious difference, even if the production processes are different. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). Furthermore, the patentability of a product claim rests on the product formed and not on the method by which it is produced. *In re Thorpe*, 227, USPQ 984 (Fed. Cir. 1985).

18. **Claims 1-3, 9-11, 14-39, 44-48, 50-64, 66** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Martin et al. (US 5,028,484).

Martin et al. disclose adhesives comprising 50-95% acrylic polymer derived from (meth)acrylic ester, polar monomers and optional comonomers, and 5 to 50% by wt. of one or more tackifying resins. The tackifying resins are aromatic resins with a number average molecular wt. of 300-2500, Tg of 40-120°C (abstract). The tackifying resin may be grafted with acrylic monomers. Working examples disclose compositions comprising acrylic polymers and acrylic terminated poly(t-but. styrene) (columns 12-13). Given that the tackifying resin in working example in column 10 is prepared by anionic polymerization and purified by precipitation and filtration, a reasonable basis exists to believe that any unreacted monomer present would inherently be eliminated to afford a product with low residual monomer. In the alternative, the presently claimed property of low residual monomer would obviously have been present once the Martin product is provided. It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594, 596 (CCPA 1980).

**Claims 15, 16, 54-56** are product by process claims. Where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to applicants to establish an unobvious difference, even if the production processes are different. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). Furthermore, the patentability of a product claim rests

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on the product formed and not on the method by which it is produced. In re Thorpe, 227, USPQ 984 (Fed. Cir. 1985).

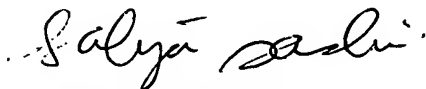
***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 272 1114.

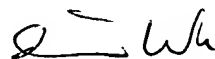
The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

March 6, 2006



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